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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,668	02/20/2002	Shrenik Deliwala	53168-500301D6	1405

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EXAMINER

CONNELLY CUSHWA, MICHELLE R

ART UNIT PAPER NUMBER

2874

DATE MAILED: 10/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/079,868

Applicant(s)

DELIWALA, SHRENIK

Examiner

Michelle R. Connelly-Cushwa

Art Unit

2874

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12,15,16,18,20,29-32 and 37-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12,15,16,18,20,29-32 and 37-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). 0703.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other.

DETAILED ACTION

Response to Amendment

The amendment filed July 24, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

In the amended paragraph beginning at line 19 of page 129, as recited on page 2 of the amendment, the new matter includes "from a relatively wide (i.e., greater than 100 μm) input waveguide 6901 into a relatively narrow (i.e., less than 3 μm)" in lines 4-5 of the paragraph; "within relatively wide input waveguide 6902" in line 9 of the paragraph; and "relatively narrow" in line 10 of the paragraph.

In the amended paragraph beginning at line 2 of page 130, as recited on page 2 of the amendment, the new matter includes "relatively narrow" in line 5 of the paragraph.

In the amended paragraph beginning at line 6 of page 130, as recited on pages 2-3 of the amendment, the new matter includes "In accordance with the present invention, evanescent coupling region 6906b may be formed to include a tapered gap portion" in lines 3-5 of the paragraph; "and may comprise a thickness on the order of 0.5 μm " in lines 5-6 of the paragraph.

In the amended paragraph beginning at line 13 of page 130, as recited on page 3 of the amendment, the new matter includes "from relatively wide input waveguide 6901 into the relatively narrow" in lines 2-3 of the paragraph; "from relatively wide input

waveguide 6901" in line 5 of the paragraph; and "relatively narrow" in line 6 of the paragraph.

In the amended paragraph beginning at line 21 of page 130, as recited on page 3 of the amendment, the new matter includes "relatively narrow" in line 8 of the paragraph.

The specification, drawings and claims as originally filed do not disclose a relatively wide input waveguide, an input waveguide having dimensions greater than 100 μm , or an input waveguide (either 6901 or 6902); that the waveguide (6904) is relatively narrow or less than 3 μm ; that the evanescent coupling region may include a tapered gap portion; or that the evanescent coupling region may comprise a thickness on the order of 0.5 μm .

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12, 15, 16, 18, 20, 29-32 and 37-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 12; the claim recites "having a thickness of less than $3\text{ }\mu\text{m}$ " in line 3 of the claim; "relatively narrow" in line 5 of the claim; "said relatively narrow waveguide having a thickness of less than $3\text{ }\mu\text{m}$ " in lines 6-7 of the claim; "relatively narrow waveguide" in lines 13-14 of the claim; "relatively narrow waveguide" in lines 16-17 of the claim; and "relatively narrow" in line 20 of the claim. The specification, claims and drawings as originally filed do not disclose these limitations.

Regarding claim 16; the claim recites "includes a tapered gap portion" in line 3 of the claim. The specification, claims and drawings as originally filed do not disclose this limitation.

Regarding claim 20; the claim recites " $0.5\text{ }\mu\text{m}$ " in line 2 of the claim. The specification, claims and drawings as originally filed do not disclose this limitation.

Regarding claim 38; the claim recites "relatively narrow waveguide" 11-12 of the claim; "relatively narrow waveguide" in line 15 of the claim; and "relatively narrow" in line 18 of the claim. The specification, claims and drawings as originally filed do not disclose these limitations.

Regarding claims 15, 16, 18, 20, 29-32, 37 and 39-42; the claims inherently contain the deficiencies of any base or intervening claims from which they depend.

Response to Arguments

Applicant's arguments with respect to claims 12, 15, 16, 18, 20, 29-32 and 37-42 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning the merits of this communication should be directed to Examiner Michelle R. Connelly-Cushwa at telephone number (703) 305-5327. The examiner can normally be reached 9:00 AM to 7:00 PM, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney B. Bovernick can be reached on 703-308-4819. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general or clerical nature should be directed to the Technology Center 2800 receptionist at telephone number (703) 308-0956.

Application/Control Number: 10/079,668
Art Unit: 2874

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MRCC

Michelle R. Connelly-Cushwa
Patent Examiner
October 14, 2003


AKM ENAYET ULLAH
PRIMARY EXAMINER